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Paper No. 9

BERNHARD P MOLLDREM JR
333 EAST ONONDAGE STREET
SYRACUSE NY 13202

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In re Application of	:	OFFICE OF PETITIONS
Mockry, et al.	:	
Application No.09/878,860	:	ON PETITION
Filed: 10 May, 2002	:	
Attorney Docket No. 530.005PA	:	

This is a decision on the renewed petition filed on 7 October, 2002, as a "Petition to Reconsider Refusal to Grant Filing Date," and thus treated as a petition under 37 C.F.R. §1.53 requesting that the application obtain a filing date of 9 June, 2001, and also treated under 37 C.F.R. §1.10, in light of the reference to a return receipt card under the regulation.

For the reasons set forth below, the petition under:

- 37 C.F.R. §1.53 is **DISMISSED**; and
- 37 C.F.R. §1.10 is **DISMISSED**.

This application was deposited on 9 June, 2001. However, on 15 March, 2002, the Office mailed a "Notice of Incomplete Nonprovisional Application" and indicated that no filing date was granted for the application because "the specification does not include a written description of the invention"

Petitioner responded with a petition on 10 May, 2002, which was dismissed on 14 August, 2002.

Petitioner then filed the instant petition on 7 October, 2002, contending that:

- Petitioner's date-stamped (9 June, 2001), receipt card indicates that the Office acknowledged receipt Petitioner's application including at least one copy of the Provisional Application;
- therefore, that evidence and acknowledgment should suffice to obtain a filing date as to the omitted description.

While Petitioners can report what they that they recall doing more than 17 months prior to this

writing and submit what purports to be a copy of a certified copy of their provisional application (Provisional Application No. 60/211,208), Petitioners' receipt card does not detail the contents more specifically than "copies of provisional"--e.g., there is no indication as to what provisional is being referenced, the number of pages included, or the elements contained therein (See: MPEP §503.¹);

The Statutes and Rules of Practice before the Office provide many tools for applicants, patentees and practitioners to protect their prospective or actual property rights and those of their clients. However, persons who fail to use the tools, fail to gain the protections.

¹ The commentary at MPEP §503 provides in pertinent part:

§503 Application Number and Filing Receipt

37 C.F.R. §1.54. *Parts of application to be filed together; filing receipt.*

(a) It is desirable that all parts of the complete application be deposited in the Office together; otherwise, a letter must accompany each part, accurately and clearly connecting it with the other parts of the application. See § 1.53(f) and (g) with regard to completion of an application.

If a self-addressed postcard is submitted with a patent application, that postcard will be provided with both the receipt date and application number prior to returning it to the addressee. The application number identified on such a postcard receipt is merely the preliminary assignment of an application number to the application, and should not be relied upon (e.g., with respect to foreign filings) as necessarily representing the application number assigned to such application. See 37 C.F.R. 1.53(b).

The identifying data on the postcard should include:

(A) applicant's name(s);

(B) title of invention;

(C) number of pages of specification, claims (for nonprovisional applications), and sheets of drawing;

(D) whether oath or declaration is included;

(E) a list of any additional forms included with the application (e.g., application transmittal form, application data sheet, fee transmittal form, and/or provisional application cover sheet); and

(F) amount and manner of paying the fee.

A return postcard should be attached to *each* patent application for which a receipt is desired. It is important that the return postcard itemize all of the components of the application. If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO).

RETURN POSTCARD

If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application). The postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as *prima facie* evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the post-card initialed by the person receiving the items.

Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as *prima facie* evidence of receipt of that item in the USPTO.

As has been discussed above, Petitioner's postcard was/is insufficiently detailed to determine what was or was not received by the Office (MPEP §503).

Therefore, absent a sufficiently detailed receipt postcard the petition under 37 C.F.R. §1.10 must be and hereby is **dismissed**.

Moreover, other than the unidentified "provisional" and fees, declarations and receipt card, Petitioners' own receipt card otherwise references only "PAGE 'CLAIMS[,]" there is no reference to a written description, which is a required element of a non-provisional application without which an application cannot obtain a filing date.

Petitioners contend that they received a filing receipt dated 20 December, 2001, and that receipt is evidence that the description (through the copy of their provisional application) was received by the Office. In fact, the receipt makes no reference to the description--rather it addresses, *inter alia*, the number of claims identified in Petitioners' application. Moreover, the language of the receipt indicates that changes may be expected

Therefore, absent clear and specific evidence that all requisite components of the application were included on the date of first deposit (i.e., 6 June, 2001), the petition under 37 C.F.R. §1.53 for a filing date of 6 June, 2001, must be and hereby is **dismissed**.

Because this petition was not occasioned by the Office, the fee will not be refunded.

The application is being returned to OIPE for further processing with a filing date of 10 May, 2002, using the pages of specification filed on that date, and then for examination in due course..

Telephone inquiries concerning this decision may be directed to the undersigned at (703)305-9199.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy